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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/240,053	01/29/1999	CLEMENT W. BOWMAN	PROGRID	6857

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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/240,053

Applicant(s)
Bowman

Examiner
Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 10, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

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DETAILED ACTION

1. Claims 1-20 are presented for examination. Applicant filed an amendment on 10/10/2001 amending claim 1, canceling claim 5 and adding claim 21. Applicant further filed an amendment on 1/10/2003 canceling claim 21. New grounds of rejection are established for claims 1-20 based on 35 USC 101 as set forth in detail below

Response to Arguments

2. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.
3. The Examiner withdraws the rejection of claim 21 based on 35 USC 112(1) in light of Applicant's cancellation of claim 21.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and

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(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology (e.g. computer system) within the recited steps of the claimed method of manufacturing a chart reflecting the value of an intangible asset. The recited steps constitute an idea on how to create and utilize the chart.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case the claimed method recites steps for creating a chart reflecting the value of an intangible asset..

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Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claims 1-16 are deemed to be directed to non statutory subject matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blake et al., "The Managerial Grid"(hereinafter The Managerial Grid) in view of Canguilhem, Pat. No. 3,628,904.

As for claim 1, applicant cites a method of evaluating an intangible asset of interest which comprises the steps of: establishing first and second variables related to the value of the intangible asset of interest; establishing a series of performance criteria statements for the value of the first and second variables; scoring each of said performance criteria statements; summing a plurality of scores to generate first and second total scores based upon the extent to which individual statements accurately describe the intangible asset of interest; transforming physical media into a chart having a first and second axes each of which relates to one of the variables; physically

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plotting a point on the chart at the location that corresponds to the first and second total scores and using the chart in making a decision regarding the value of the intangible asset of interest.

The Managerial Grid discloses two variables (concern for people and concern for production); various criteria statements (the five statements shown in Fig. 1); first and second scores (1,1; 9,9; 1,9 etc.); a chart with two axes each relating to one of the variables (concern for people and concern for production) and plotting a point on the chart corresponding to the first and second total scores (1,1; 9,9; 1,9 etc.).

The Managerial Grid does not teach the use of the chart in making a decision regarding the value of the asset. However, the Examiner takes official notice that it was well known in the statistical arts that graphical illustrations are used to represent data in order to create a user friendly illustration or depiction of abstract data and data trends and to facilitate decision making. Therefore, it would have been obvious to one of ordinary skill in the art to have utilized The Managerial Grid for decision making regarding the value of an asset for the motivation stated above.

The Managerial Grid does not explicitly disclose a first independent variable and a second independent variable related to a specific intangible asset of interest.

However, Canguilhem discloses a first independent variable and a second independent variable related to a specific intangible asset of interest (i.e. means for providing quantified values for concepts which are of a subjective nature and multidimensional and which have been regarded as unmeasurable and thus nonassessable for purposes of data processing by computer)(col. 2,

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lines 20-26, lines 40-60). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a first independent variable and a second independent variable related to a specific intangible asset of interest as disclosed by Canguilhem within the Managerial Grid for the motivation of providing quantified values for concepts which are of a subjective nature (col. 2, lines 20-26).

The Managerial Grid does not explicitly disclose

scoring each of the performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said intangible asset of interest.

However, Canguilhem discloses scoring each of the performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said intangible asset of interest (i.e. pyramid value assessment, sequencing)(col. 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include scoring each of the performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said intangible asset of interest as disclosed by Canguilhem within the Managerial Grid for the motivation of providing quantified values for concepts which are of a subjective nature (col. 2, lines 20-26).

As for claim 2, applicant further claims the generating step as comprising: choosing criteria statements which most closely describe the asset being evaluated, determining first and second scores for each of the criteria statements and summing the scores for the first and second

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variables. The Managerial Grid discloses the use of criteria statements and scores of each of these statements with respect to each of the variables.

As for claim 3, The Managerial Grid does not explicitly disclose the method of claim 1 further comprising the steps of assigning first and second weighing factors reflecting the extent of impact of the criteria statements on the first and second variables and using the weighing factors in determining first and second total scores.

However, Canguilhem discloses the steps of assigning first and second weighing factors reflecting the extent of impact of the criteria statements on the first and second variables and using the weighing factors in determining first and second total scores (i.e. greater importance attributed to certain factors relative to others)(col. 2, lines 60-67). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the steps of assigning first and second weighing factors reflecting the extent of impact of the criteria statements on the first and second variables and using the weighing factors in determining first and second total scores as disclosed by Canguilhem within the Managerial Grid for the motivation of providing quantified values for concepts which are of a subjective nature (col. 2, lines 20-26).

As for claim 4, applicant cites a method of placing a label in each of the four quadrants of the chart of claim 1 to represent the extent to which points in a quadrant reflect balance between the first and second variables. The Examiner takes official notice that it was well known in the

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statistical arts that the quadrants of a graph provide an indication of the comparative value of each of two variables which define the axis of the graph. Such labeling provides a key as to what that area of the graph represents and it would have been obvious to one of ordinary skill in the art to include this feature within the Managerial Grid for the motivation stated above.

As for claims 6-17, applicant cites the various types of assets being evaluated and a corresponding set of variables for each of these assets. The Managerial Grid does not explicitly disclose this feature.

However, the Managerial Grid discloses evaluating a specific asset and a corresponding set of variables for the specified asset related to the performance of an organization or asset (i.e. Management's concerns for production versus management's concerns for its employees)(see The Managerial Grid). It would have been an obvious to one of ordinary skill in the art to have utilized The Managerial Grid for evaluating other types of assets that are related to the performance or value of the asset in order to customize the Grid for particular preferences and/or needs of the user of the system.

As for claim 18, applicant cites a chart created by the method of claim 1 for providing a graphical indication of the value of an intangibles asset of interest.

The use of graphical illustrations to represent data was well known in the art and this limitation was previously discussed in claim 1 above.

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6. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Managerial Grid as applied to claim 1 above, and further in view of Turnbull, Peter, "A Review of Portfolio Planning Models for Industrial Marketing and Purchasing Management"(hereinafter Turnbull).

As to claim 19, The Managerial Grid does not explicitly disclose the method according to claim 1, further comprising the steps of:

calculating the future value of an intangible asset by iterating said scoring, summing, transforming, and plotting steps using new rating levels, determined through a code in the format x, y, z where x is a number of improvement steps which the asset is likely to achieve if its current position is at a lowest performance level, y is a number of improvement steps that the asset is likely to achieve if its current position is at a next highest performance level, and z is a number of improvement steps the asset is likely to achieve if its current position is at a next highest performance level.

However, Turnbull discloses a system of strategic planning that enables management to assess by graphic representation the current position of a company, the projected future position of a company and the desired future position of a company (see abstract and page 7). Turnbull further discloses generating future business portfolios (i.e. calculating the future value of the intangible asset (what-if analysis)) based on project trends of the factors considered in order to identify major strategic issues facing the company (see page 12, last two paragraphs). It would

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have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include calculating the future value of an intangible asset by iterating said scoring, summing, transforming, and plotting steps using new rating levels, determined through a code in the format x, y, z where x is a number of improvement steps which the asset is likely to achieve if its current position is at a lowest performance level, y is a number of improvement steps that the asset is likely to achieve if its current position is at a next highest performance level, and z is a number of improvement steps the asset is likely to achieve if its current position is at a next highest performance level within the Managerial Grid in order to identify major strategic decisions facing the company (page 12, last paragraph).

As to claim 20, The Managerial Grid does not explicitly disclose the method according to claim 1, further comprising the steps of:

repeating said steps of establishing, scoring, summing, transforming, and plotting for a plurality of intangible assets of interest, whereby said chart is caused to show a plurality of points corresponding to said plurality of intangible assets of interest.

However, Turnbull discloses a system of strategic planning that enables management to assess by graphic representation the current position of a company, the projected future position of a company and the desired future position of a company (see abstract and page 7). Turnbull further discloses repeating said steps of establishing, scoring, summing, transforming, and

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plotting for a plurality of intangible assets of interest, whereby said chart is caused to show a plurality of points corresponding to said plurality of intangible assets of interest (i.e. the company is divided into strategic business units (SBUs) which are positioned on the business screen against two corporate dimensions)(see GEC's Nine Cell Strategic Business Screen, pages 13 and 14). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include repeating said steps of establishing, scoring, summing, transforming, and plotting for a plurality of intangible assets of interest, whereby said chart is caused to show a plurality of points corresponding to said plurality of intangible assets of interest within The Managerial Grid in order to identify major strategic decisions facing the company (page 12, last paragraph).

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 6:30 AM to 4:00 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Patent Examiner

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March 24, 2003